

Attached is a declaration of the inventor clarifying that he was not aware before he invented the present invention of any necklaces with solid sports beads.

The patent examiner cites reasons why one would wish to add the features of the dependent claims to the independent claims. While all these reasons seem logical now, it does not mean that the invention would have been obvious at the time it was made.

The Examiner alleges that it would be obvious to combine the prior art mentioned by the patent applicant at page 1 of the application as filed to arrive at applicant's invention as claimed in Claims 37-43 and 47-49. Applicant respectfully disagrees with this allegation.

The prior art mentioned by the patent applicant at page 1 of the application as filed merely shows that some elements of the claimed invention are old. "That all elements of an invention may have been old (the normal situation), or some old and some new, or all new, is however, simply irrelevant. Virtually all inventions are combinations and virtually all are combinations of old elements. A court must consider what the prior art as a whole would have suggested to one skilled in the art." Environmental Designs, Ltd. v. Union Oil Co., 218 USPQ 865, 870 (CAFC 1983). "Obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching or suggestion supporting the combination. Under [35 U.S.C.] Section 103, teachings of references can be combined only if there is some suggestion or incentive to do so." ACS Hospital Systems v. Montefiore Hospital, 221 USPQ 929, 933 (CAFC 1984) and cases cited therein (emphasis in original). Applicant has stated in his declaration of 29 January 2003 that it was not obvious to him or anyone he knew to combine the teachings of the prior art of which he was aware to reach applicant's invention.

Motivations

Thus, "[t]here is nothing in the prior art references, either singly or in combination, 'to suggest the desirability, and thus the obviousness,' of designing" a method as claimed in the rejected claims. In re Deminski, 230 USPQ 313, 315 (CAFC 1986) and cases cited therein (emphasis in original). It is therefore respectfully submitted that the rejected claims are allowable.

The Declaration dated 29 January 2003 and the attached declaration attest to the commercial success of the invention and copying by others of the claimed invention, both indications of non-obviousness of the invention. Applicant requests that the patent examiner consider this evidence of non-obviousness when considering the patentability of the claims under

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35 U.S.C. § 103(a) (sec, c.g., MPEP Sections 716.01(a) through 716.06).

Applicant respectfully submits that the application is in condition for allowance. A Notice of Allowance is hereby respectfully requested.

Should the Examiner feel that a telephone conference would advance the prosecution of this application, he is encouraged to contact the undersigned at the telephone number listed below.

Applicant respectfully petitions the Commissioner for any extension of time necessary to render this paper timely.

Please charge any additional fees due or credit any overpayment to Deposit Account No. 50-0694.

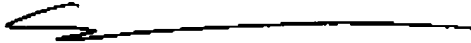
Respectfully submitted,



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Signature

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Seth M. Nehrbass  
(Typed or printed name of person signing)

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